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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,162	06/26/2003	Kimihiko Sano	03383/LH	7848

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/609,162	Applicant(s) SANO ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5,6,8 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,5,6,8 and 13-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claims 2, 5, 6, 8, 10 and 13-25 as anticipated by Okabe of record in the Final Office Action mailed 9/16/05, Pages 2-4, Paragraph #6 has been withdrawn due to the Applicant's amendment filed 11/30/05.
2. The 35 U.S.C. 103 rejection of claims 26 and 27 over Okabe in view of Odaka of record in the Final Office Action mailed 9/16/05, Page 5, Paragraph #8 has been withdrawn due to the Applicant's amendment filed 11/30/05.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 5, 6, 8 and 13-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2, 5, 6, 8 and 13-27, the phrase "like" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

Regarding claims 2, 22 and 26, the recitation “widthwise end” is deemed vague and indefinite. It is not clear what is the “widthwise end”? Clarification is requested.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5, 6 and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe (JP 2-206140; refer to the translation copy).

Okabe discloses a plate-like protective film comprising a plate-like material main body (Fig. 3, element 1) which protects a protected plate-like material structure (Fig. 3, element 3), projections which are arranged continuously in predetermined areas of the plate-like material main body and which are formed by respective parts of the plate-like material main body to extend from a base portion of the plate-like material main body (Fig. 3, element 10a), wherein each of the projections comprise a crown portion having a surface that is a plane that is substantially parallel with a main surface of the protected plate-like material structure (Fig. 3, element 10a), and a side wall portion extending from the crown portion (Fig. 3, element 10). However, Okabe fails to disclose an amount by which the projection provided at one widthwise end of the plate-like protective film is shifted with respect to a corresponding projection at another widthwise end is not smaller than $\frac{1}{4}$ pitch and is not larger than $\frac{3}{4}$ pitch. Though the optimum range for the pitch would be readily determined through routine experimentation by

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one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the projections in Okabe to have the amount by which the projection provided at one widthwise end of the plate-like protective film is shifted with respect to a corresponding projection at another widthwise end be not smaller than $\frac{1}{4}$ pitch and not larger than $\frac{3}{4}$ pitch, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claim 5, the plurality of projections (Fig. 3, element 10a) project in at least two different directions from the base portion of the plate-like material main body. Regarding claim 6, the plurality of projections comprise first projections (Fig. 3, element 10a) projecting from one surface of the plate-like material main body, and second projections (Fig. 3, element 10a) projecting from another surface of the plate-like material main body, and the first and second projections are arranged alternately along a direction in which the projections are arranged (Fig. 3, element 10a). Regarding claim 14, the projections are substantially trapezoidal as viewed from an end surface side of the plate-like material main body (Fig. 1(b), element 10). Regarding claims 15 and 16, the projections are substantially u-shaped and semicircular as viewed from one surface side of the plate-like material main body (Fig. 2(b), element 20). Regarding claims 17-19, the protected plate-like material structure (Fig. 3) comprises interconnect patterns and electronic components such as semiconductor chips, and the predetermined areas of the plate-like material main body are not superimposed on the interconnect patterns and electronic components (see page 2, paragraphs 2 and 3). Regarding claim 20, the plate-like material main

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body (Fig. 3, element 1) is long enough to protect the protected plate-like material structure (Fig. 3, element 3). Regarding claim 21, the protected plate-like material structure comprises sprocket holes (Fig. 1(c), element 3a), and the predetermined areas of the plate-like material main body are in proximity to the sprocket holes (Fig. 1(c), element 10a). Regarding claim 22, the protected plate-like material structure comprises sprocket holes at opposite widthwise ends thereof (Fig. 1(c), element 3a) and the predetermined areas of the plate-like material main body are the opposite widthwise ends of the plate-like material main body (Fig. 1(c), element 10a). Regarding claim 23, the plate-like material main body has a sheet form (Fig. 3, element 1) so as to protect the protected plate-like material structure, which also has a sheet form (Fig. 3, element 3). Regarding claim 24, the predetermined areas of the plate-like material main body are two opposite side areas of the plate-like material main body (Fig. 3, element 10a). Regarding claim 25, the predetermined areas of the plate-like material main body are at least four side areas of the plate-like material main body (Fig. 1(a), element 10).

7. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe (JP 2-206140; refer to the translation copy) in view of Odaka (JP 2002-076064; refer to the translation copy).

Okabe discloses the claimed plate-like protective film as shown above except for conductive layers being provided on respective surfaces of the plate-like material main body. Odaka teaches that it is old and well-known in the art to provide conductive layers on respective surfaces of a plate-like material main body (Drawing 5, elements 28) for the purpose of preventing generation of electrostatic charge to the utmost, peeling of conductive films and generation of conductive foreign particles accompanied by peeling. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided conductive layers on respective surfaces of the plate-like material main body in Okabe as suggested by Odaka in order to prevent generation of electrostatic charge to the utmost, peeling of conductive films and generation of conductive foreign particles accompanied by peeling.

8. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe (JP 2-206140; refer to translation copy).

Okabe discloses a plate-like protective film comprising a plate-like material main body (Fig. 3, element 1) which protects a protected plate-like material structure (Fig. 3, element 3), projections which are arranged continuously in predetermined areas of the plate-like material main body and which are formed by respective parts of the plate-like material main body to extend from a base portion of the plate-like material main body (Fig. 3, element 10a), wherein each of the projections comprise a crown portion having a surface that is a plane that is substantially parallel with a main surface of the protected plate-like material structure (Fig. 3, element 10a), and a side wall portion extending from the crown portion (Fig. 3, element 10). However, Okabe fails to disclose the plurality of crown portions having different widths measured along a direction of arrangement of the projections and the respective gap portions between the plurality of projections having at least two different widths measured along a direction of arrangement of the projections.

Normally, it is to be expected that a change in shape of the crown portions of the projections would be an unpatentable modification. Under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed

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produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. MPEP 2144.04 IV (B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify the shape of the crown portions of the projections in Okabe to have different widths and the gap portions therebetween having different widths measured along a direction of arrangement of the projections. One skilled in the art would have been motivated to do so in order to form a plate-like protective film, since it has been held that the change in form or shape of the crown portions of the projections would be an unpatentable modification in absence of showing unexpected results.

Response to Arguments

9. Applicant's arguments with respect to claims 2, 5, 6, 8 and 13-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine A. Simone
Examiner
Art Unit 1772
December 6, 2005



WILLIAM P. WATKINS III
PRIMARY EXAMINER